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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,548	08/08/2001	Shoukat Dedhar	KINE001CIP4	5127
24353	7590	06/28/2005	EXAMINER	
BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303			CHEN, SHIN LIN	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,548

Applicant(s)

DEDHAR ET AL.

Examiner

Shin-Lin Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Applicants' petition, filed 2-16-05, regarding the restriction requirement has been entered. A decision on the petition has been mailed on June 2, 2005. The petition has been granted-in-part, and only SEQ ID Nos. 6 and 18 will be examined.

Priority

A search through the sequence database shows that the nucleotide sequence of SEQ ID No. 18 has not been disclosed in Application No. 08/752,345, filed 11-19-96, and provisional application 60/009,074, filed 12-21-95. Therefore, the effective priority date for SEQ ID No. 18 is the filing date of parent application 08/955,841, filed 10-21-97.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3 and 4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The phrase "an oligonucleotide" reads on naturally occurring oligonucleotide, which is a non-patentable subject matter. This rejection could be overcome by amending the claims to recite "an isolated oligonucleotide".

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 3 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by Dedhar et al., 1997 (WO 97/23625 A1, computer printout page 4, 5).

Claims 3 and 4 are directed to an oligonucleotide comprising at least 18 nucleotides from the sequence of SEQ ID No. 18. Claim 4 specifies the inclusion of a pharmaceutically acceptable carrier.

Dedhar discloses a human cDNA sequence encoding integrin-linked kinase, Geneseq Accession No. AAT71716, which is 100% identical to SEQ ID No. 18 from base 286 to 304. The buffer solution of the cDNA clone comprising the disclosed human cDNA sequence would also contain a pharmaceutically acceptable carrier. Thus, claims 3 and 4 are anticipated by Dedhar.

4. Claims 3 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by Adams et al., April 1997 (EST Accession No. AA295328, computer printout page 2).

Claims 3 and 4 are directed to an oligonucleotide comprising at least 18 nucleotides from the sequence of SEQ ID No. 18. Claim 4 specifies the inclusion of a pharmaceutically acceptable carrier.

Adams discloses a human cDNA sequence, EST Accession No. AA295328, which is 100% identical to the sequence of SEQ ID No. 18 from base 195 to 213. The buffer solution of the plasmid vector comprising the disclosed human cDNA sequence would also contain a pharmaceutically acceptable carrier. Thus, claims 3 and 4 are anticipated by Adams.

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5. Claims 3 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by Hillier et al., August 1997 (EST Accession No. AA135079, computer printout page 6, 7).

Claims 3 and 4 are directed to an oligonucleotide comprising at least 18 nucleotides from the sequence of SEQ ID No. 18. Claim 4 specifies the inclusion of a pharmaceutically acceptable carrier.

Hillier discloses a human cDNA sequence encoding an integrin-linked kinase, EST Accession No. AA135079, which is 100% identical to the sequence of SEQ ID No. 18 from base 179 to 197. The buffer solution of the plasmid vector comprising the disclosed human cDNA sequence would also contain a pharmaceutically acceptable carrier. Thus, claims 3 and 4 are anticipated by Hillier.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Lin Chen whose telephone number is (571) 272-0726. The examiner can normally be reached on Monday to Friday from 9:30 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for this group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Shin-Lin Chen, Ph.D.



SHIN-LIN CHEN
PRIMARY EXAMINER